

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/664,867
Attorney Docket No.: Q77431

REMARKS

Claims 1-6 and 8-15 are all the claims pending in the application.

Summary of the Office Action

Claims 1-6 and 8-15 under 35 U.S.C. § 102(e).

Preliminary Matter

As a preliminary matter, the Office Action fails to acknowledge Applicant's claim to foreign priority nor does it indicate receipt of the certified copy of the priority document filed on September 22, 2003. Review of the Image File Wrapper (IFW) at the U.S. Patent and Trademark Office's official website indicates that the priority document has been received and placed in the file. In view thereof, the Examiner is respectfully requested to acknowledge Applicant's claim to foreign priority, and to indicate receipt of the certified copy of the priority document filed on September 22, 2003.

Claim Rejections

Claims 1-6 and 8-15 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2003/0118015 to Gunnarsson (hereinafter "Gunnarsson"). Applicant respectfully traverses this rejection in view of the following comments.

The present invention is directed to a technique for notifying a mobile telephone user of the availability of WLAN services. As described in the Background section of the application, a known technique would be to keep track of the location of the mobile telephone, compare this against a database of known WLAN locations, and send a message to the mobile phone user when there is a known WLAN in that location. At least one problem with this is that it is based

on stored information, and it may be, e.g., that the WLAN is not actually operational or is otherwise unavailable. According to the invention, the user's mobile data terminal (i.e., the portable computer or other device that will connect to the WLAN) detects radio signals broadcast by the WLAN, and the mobile data terminal then sends a message to the mobile telephone notifying the user that a WLAN is available.. Independent claims 1, 6, and 8 all include some variation of a mobile data terminal detecting signals broadcast by the WLAN, and informing of access to the WLAN by sending a signal from the mobile data terminal to the radiotelephone terminal.

Gunnarsson is not different from the prior art technique disclosed in Applicant's specification. That is, in Gunnarsson a mobile terminal 60 (a cellular phone), which communicates with a wireless communication network such as a TIA/EIA/IS-2000 network, and the user location is determined via the mobile terminal 60 (¶¶ 20 and 22). Then, in Gunnarsson, the user location is compared to the known location and extent of WLANs 20, e.g., from a database or other information resource within the communication network 10 (¶ 22). The wireless communication network then sends a message to the mobile telephone, as a result of which the WLAN interface in the personal computer can be activated to search for and connect to the WLAN (¶ 24).

Accordingly, it is clear that Gunnarsson does not detect the availability of the WLAN by having the mobile data terminal detect signals broadcast from the WLAN, but instead by having the mobile telephone network compare the mobile telephone location to known WLAN locations.

Turning to the position set forth in the Office Action, the Examiner alleges that the mobile data terminal and the radiotelephone terminal as set forth in some variation in claims 1, 6, and 8 are disclosed by Gunnarsson's wireless computing device 70 and mobile terminal 60, respectively (*see* page 2 of the Office Action). The Examiner further alleges that Gunnarsson in ¶ 20 discloses: detecting presence of the WLAN by receiving signals broadcasted by the WLAN with a radio receiver associated with said mobile data terminal and which is adapted to receive signals broadcasted by the WLAN. In support of this position, the Examiner provides the following quote from Gunnarsson: ““may comprise a message **broadcast to all mobile terminals** in the relevant cell 12 or sector”” (*see* page 2 of the Office Action). The actual quote of Gunnarsson set forth in ¶ 20, however, recites:

In one embodiment of the present invention, wherein the determination of the location of a mobile terminal 60 is simply an identification of the cell 12 or sector in which the mobile terminal 60 is operating, the alert **transmitted by the wireless communication network 10** if a WLAN 20 is available in the cell 12 or sector (as described more fully below) may comprise a message broadcast to all mobile terminals 60 in the relevant cell 12 or sector. (emphasis added)

In other words, the signal broadcast to the terminals is from the mobile phone network, not from the WLAN as is required in claim 1. Gunnarsson also does not teach or suggest having the mobile data terminal send a message to the mobile telephone advising it that a WLAN has been detected, as is required in claims 1, 6 and 8, Gunnarsson instead sends a message to the mobile telephone from the mobile telephone network, and the signal is not telling the mobile telephone that a WLAN signal has been detected but instead that there “should” be one there somewhere.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/664,867
Attorney Docket No.: Q77431

For at least these exemplary reasons, claims 1, 6, and 8 are patentably distinguishable from Gunnarsson. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claims 1, 6, and 8 and their dependent claims 2-5 and 9-15.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: February 21, 2006

Respectfully submitted,



Nataliya Dyvorson
Registration No. 56,616

Attorney Docket No.: Q77431